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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/913,811	09/24/97	SUGIHARA	H 356972020100

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HM22/1201

EXAMINER

BASKAR, P

ART UNIT

PAPER NUMBER

1645

19

DATE MAILED:

12/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
08/913,811

Applicant(s)

SUGIHARA HIROKAZU

Examiner

Padma Baskar

Group Art Unit

1645



☒ Responsive to communication(s) filed on Oct 30, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) 1-11 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 12-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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Response to Amendment

1. The amendment filed on 10/30/2000 has been entered into the record. Claims 12-16 have been amended. Claims 1-16 are pending in the application. Claims 1-11 are withdrawn from consideration as non-elected invention. Claims 12-16 are currently under consideration.
2. The text of Title 35 of the U.S. Code not reiterated herein can be found in the previous office action.

Rejections Withdrawn

3. In view of applicants arguments and amendments of record, examiner has withdrawn 35 U.S.C. 112, second paragraph rejections for claims 12-16.
4. In view of applicants arguments and amendments of record, examiner has withdrawn 35 U.S.C. 103(a) rejections for claims 12-16.
5. In view of applicants arguments and amendments of record, examiner has withdrawn new matter rejections.

Rejections Maintained

6. Rejection of claims 12-16 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,563,06 is maintained . The rejection is maintained for the same reasons as set forth in the previous office action.

Claims 12-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5,563,067. Although the conflicting claims are not identical, they are not patentably distinct from each other because

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both claims of the instant application and those of U.S. Patent No. 5,563,067 are drawn to apparatus and a method for measuring the electrical and physical characteristic of cells. While 1-13 of U.S. Patent No. 5,563,067 specifically recite an apparatus for measurement of electrical and physical characteristic of cells, it does not specifically recite measuring the properties of tissue with or without addition of medicines. However, it would have been obvious to one of ordinary skill in the art to substitute any tissue as recited in the claimed methods and device in order to measure electrical and physical properties of tissue with or without addition of medicines.

Applicant's arguments filed on 10/30/00 have been fully considered but they are not found persuasive. Applicant argues that the instant claims require the presence of material enhancing the adhesion of the tissue to the micro electrode plate. If it would have been obvious to add the adhesive material, it is incumbent on the office action to recite a reference to bridge the gap between the claims of the prior patent and the claims recited. Examiner would like to bring applicants attention to U.S. Patent NO 5,563,067, column 11, lines 6-47. The prior art teaches processing of the electrode surface for enhancing cell adhesive property. In order to enhance cell adhesive property on the surface of the electrode, collagen gel was formed on the surface of the electrode (column 11, lines, 6-10). Especially this process is useful for culturing the nerve cells or organs (i.e. tissue, column 11, lines 48-50). Therefore, the prior art teaches adhesive material.

Status of Claims

7. No claims are allowed.

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Conclusion

8. This application contains claims 1-11 drawn to an invention nonelected with traverse in Paper No.8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01. 9.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padma Baskar whose telephone number is (703) 308-8886. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4 PM EST


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Padma Baskar Ph.D

11/30/00




RODNEY P. SWARTZ, Ph.D.
PRIMARY EXAMINER
11/30/00